REMARKS

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

In order to expedite the prosecution of this application, claims 64-66, 68-70, and 74-80 have been amended. Claims 61-80 are now in this application.

Regarding the Drawings

The Examiner objected to Figures 1-3 because the line art appears to be rasterized. The Applicant respectfully submits replacement drawing sheets containing Figures 1-3 which are in compliance with 37 CFR 1.84(p)(5). The replacement drawing sheets are formal drawings correcting all informalities indicated by the Examiner. No new matter was added.

Regarding the Claim § 112 Rejections

The Examiner rejected claims 74-79 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Particularly, the limitation of nanostructure fails to provide additional direction regarding how the laminate is different by virtue.

Claims 74-80 have been amended in the preamble to change “nanostructure” to “high impact strength, elastic laminate system”. Thereby relating claims 74-80 to independent claim 61, but which further adds limitations to the subject matter of claim 61.

The Examiner rejected claims 74-79 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 74-80 have been amended in the preamble to change “nanostructure” to “high impact strength, elastic laminate system”.

The Examiner rejected claims 64-66, 68, 75 and 79 under 35 U.S.C. 112, second paragraph, because the phrase "but not limited to" renders the claims indefinite.

Claims 64-66, 68, 75 and 79 have been amended to remove the phrase "but not limited to", thereby overcoming this rejection.

Regarding the Claim § 102 Rejections

The Examiner rejected claims 61-67, 74-76 and 79-80 under 35 U.S.C. 102(b) as being anticipated by Percy. Regarding independent claim 61, the Examiner states that "whereby the tube or weft yarns could be interlaced with alternating warp yarns". Emphasis is put on the word could, since the Percy reference does not disclose the use of at least **two** "inner plies placed between the first and second outer layers" in combination with "at least one dissipating element between said inner plies", as described in claim 61 of the present application. The Percy reference only and specifically discloses a **single** glass fiber cloth body (1) coated with rubber which penetrates the glass fiber cloth [col. 2 lines 17 and 18]. The Percy reference makes no suggestion or description of the rod like elements illustrated in Figure 1, or how the rod like elements function with the invention. Additionally, Figure 1 of the Percy reference does **not** disclose the rod like elements **between** the inner plies which are located between the first and second outer layers. Since the Percy reference does not disclose or describe the use of "at least two inner plies" in combination with "at least one dissipating element", then the Percy reference is believed to not be a proper 35 U.S.C. 102 (b) rejection.

The Applicant requests that the Examiner reconsiders his rejections of the invention in view of the well established principle that small differences in a crowded art can constitute patentable improvement. See *In re Baum*, 51 USPQ 470 (CCPA 1941) and *In re Lange*, 126 USPQ 365 (CCPA 1960). In considering this principle, the Applicant would also request that the Examiner take note to the court decision which notes that "apparent simplicity has been held to furnish strong argument for patentability where, as here, a need has existed for a structure of the nature disclosed and claimed. The fact that a solution to a problem is simple, or appears to be simple when viewed in

retrospect, does not mean that the solution was obvious when it was conceived." See *Ellipse corp. v. Ford Motor Co.*, 171 USPQ 513.

Additionally, the Examiner also states that in the Percy reference "the tubular weft yarns between the unidirectional tubular warp plies constitute a dissipating element" and "by redirecting load to dampens the noise in braking system ipso facto (C1:L8-21)". The Applicant is confused by the Examiner's reliance of this notion since the Percy reference makes no disclosure, reference, teaching or suggestion of a dissipating element or the use of "redirecting load". The Applicant respectfully believes that the Examiner is modifying the Percy reference to suit this rejection. It can therefore be appreciated that the limitation in claim 61 of "at least two inner plies placed between the first and second outer layers" in combination with "at least one dissipating element between said inner plies" is structurally different to the Percy reference.

The Applicant respectfully points out that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531,1534,28 USPQ2d 1955, 1957 (Fed.Cir.1993)", see MPEP §2112(IV). It is believed that the Examiners anticipation rejection of the two inner plies and the dissipating element between the two plies in claim 61 is in error. The Examiner states in this office action that "whereby the tube or weft yarns could be interlaced with alternating warp yarns" and "The dissipating elements can be… having the function of dissipation and redirection". It can therefore be appreciated, by the Examiner's own admission that the structure in the Percy reference may, could or can be interlaced and used for dissipation is thereby not sufficient to establish inherency. Therefore, since the Percy reference does not disclose, teach, or suggest the structure or use of two inner plies and a dissipating element between the two plies, that the structure relied upon by the Examiner may be interlaced and used for dissipation, and that MPEP §2112(IV) states that if a characteristic may occur or be present in the prior art is not sufficient to establish inherency, then it is respectfully concluded and proven that the limitations in claim 61 are not inherently found in the Percy reference and that claim 61 is in condition for allowance.

The Applicant further points out that inherency may not be established by probabilities or possibilities, and by the mere fact that a certain thing may result from a given set of circum-stances is not sufficient. See *In re Robertson*,169 F.3d 743,745,49 USPQ2d 1949,1950-51 (Fed.Cir.1999), wherein the courts ruled that a claimed invention having three separate elements and the prior art reference has two elements was held that the reference did not disclose a separate third element, either expressly or inherently. With this in mind, the singe glass fiber cloth (1) and the illustrated rod like elements (no reference number) of the Percy reference can not be used to anticipate the two inner plies and the dissipating element between the two plies in claim 61. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See *In re Runion*, 1993 U.S. App. Additionally, the principle of inherency is a question of fact, and that an inherent property used in an anticipation rejection has to flow naturally from what is taught in a reference. See *Stoller v. Ford Motor Co.*, 1991 U.S. App. LEXIS 1084; 18 U.S.P.Q.2D (BNA) 1545.

Regarding independent claims 74 and 79, the Percy reference does not disclose, teach or suggest the use of "at least one additional layer placed on any one of said outer layers." To modify the Percy invention to include an additional layer on the nitrile rubber sheetings (2b) would change the principle of operation of the Percy invention, therefor not usable since the rubber sheetings are specifically designed to be in contact with the elements of operation.

Claims 69, 70, 74, 78 and 79 have been amended to remove the limitation "rubber" so that the first and second outer layers and the additional outer layer are not made of rubber. The removal of the rubber limitation thereby further overcomes the rejection based on the Percy reference.

Claims 62-67 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from claim 61, claims 75 and 76 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from claim 74, and claim 80 is felt to patentably distinguish over the prior art references because of its above-mentioned dependency from claim 79.

The Examiner rejected claims 68-71 and 77-78 under 35 U.S.C. 102(b) as being anticipated by Percy as applied to claims 67 and 76 with evidence from Shigley et al. The Examiner states that vulcanized nitrile rubber "is known in the art to be corrosion resistant".

Claims 68 and 77 have been amended to remove the limitation "corrosion resistant", thereby overcoming this § 102(b) rejection. Claims 69-71 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 68, and claim 78 is felt to patentably distinguish over the prior art references because of its above-mentioned dependency from amended claim 77.

Furthermore, the Examiner stated that "Both the matrix and outer layers comprise rubber (C1:L48-C2:L4) corresponding with Applicant's [[Claims 69-71 and 77-78]]." Claims 69, 70 and 78 have been amended to remove the limitation "rubber", thereby overcoming this rejection.

Regarding the Claim § 103 Rejections

The Examiner rejected claim 72 under 35 U.S.C. 103(a) as being unpatentable over Percy in view or Brydson. Particularly, the Examiner states that the Brydson reference teaches properties of nitrile rubber with the impact resistance easily optimized, and that this limitation as claimed is unpatentable.

Claim 72 is dependent from claim 69 which describes the dissipating element as being made from a group of materials, one of which is rubber. Claim 69 has been amended to remove the rubber limitation therefrom, so claim 72 is no longer directed toward a rubber material. The Applicant respectfully believes that the Brydson and Percy references are no longer proper § 103 rejections because the claimed invention is not directed to a rubber material, and thereby would not have been obvious to one skilled in the art.

The Examiner rejected claim 73 under 35 U.S.C. 103(a) as being unpatentable over Percy in view or Brydson and Avallone et al. Particularly, the Examiner states that the Brydson and Avallone et al. references teach that the specific gravity of the rubber

ranges from 1.02 to 1.07, “thus the density of the composite is also a result-effective variable to obtain dimensional properties of the composite.”, and that this limitation as claimed is unpatentable.

Claim 73 is dependent from claim 69 which describes the dissipating element as being made from a group of materials, one of which is rubber. Claim 69 has been amended to remove the rubber limitation therefrom, so claim 73 is no longer directed toward a rubber material. The Applicant respectfully believes that the Brydson, Avallone et al., and Percy references are no longer proper § 103 rejections because the claimed invention is not directed to a rubber material, and thereby would not have been obvious to one skilled in the art.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Applicant has endeavored to address all of the Examiner’s concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above-remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions.

Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at (403) 444-5695, or email at davidguerra@internationalpatentgroup.com

No additional fee is due.

Respectfully Submitted,

/David A. Guerra/

David A. Guerra
Registration No.: 46,443
Customer No.: 29,689

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On (Date) 02/22/2008 by David A. Guerra /David A. Guerra/